

REMARKS/ARGUMENTS

Favorable consideration of this application is respectfully requested. Applicant has rewritten claims 1, 2, 20, 23, 24, 26, 28, and. Favorable reconsideration of this application is, consequently, earnestly solicited in view of the following remarks.

Applicant will be filing a Declaration under 37CFR 1.131 demonstrating that the subject invention was reduced to practice before in this country prior to November 9, 1999 (herein after referred to as the effective date), which was the provisional filing date of U.S. Provisional Application 60/164,429 on which U.S. Patent Application 09/614,504, and International Publication Number WO 01/35235 to Garry Chinn et al(herein after referred to as the Chinn reference).

The subject application was filed as a utility patent application on January 5, 2001 and which claims the benefit of priority to U. S. Provisional Application 60/174,785 filed January 6, 2000. A copy of the original provisional application is included with this response. The provisional application refers on page 3 sentence numbered "7 Text only information...is conducive to hand held web browsing tools such as wireless telephones and palm pilots..." and in Figures 6-9 showing single vertical column lists, and in Fig. 10 which "...allows a hierarchical menu to be constructed in real time from any starting point...."

The objection to claim 24 is noted. Applicant has amended first claim 24 accordingly to be 23. Removal of this objection is requested.

Claims 1-2 and 29 were rejected under sec. 112, second paragraph as being indefinite. Applicant has amended claims 1 and to correct for antecedent bases, and has amended the claim 29 to depend from claim 28. Removal of this rejection is requested.

Claims 26-27 were rejected under sec. 102e as being anticipated by Bidz. Claims 26-27 have been amended to include "accessing the web... through a handheld display

device that is selected from at least one of a pager, a cell phone, and a PDA(personal digital assistant)....” until the user reaches a “single vertical column of an finite selection list menu” and “viewing the single column of the finite selection list of the classification by scrolling down the finite selection list on the handheld display device, without the inputting of any search queries...” Clearly, as admitted by the examiner, these features are not described, taught or suggested by Bidz. Therefore removal of the Bidz reference is respectfully requested.

Claims 1, 2, 6-9 and 12-13 were rejected under sec. 103 as being unpatentable over Bidz in view of Vocal Point(International Publication WO 01/35235, herein after referred to as Chinn). As noted previously, Applicant will provide an affidavit that demonstrates the invention was reduced to practice before the 11/9/1999 provisional filing date of the U.S. Patent Application which is the bases for the Chinn reference. Thus, removal of this rejection is respectfully requested.

Furthermore, Applicants strongly disagree with the examiner’s statements that in regard to claimed features of “second subcategory heading being solely listed in a single vertical column on the third menu page with separate subcategory headings solely on each line...” is not novel and the “Examiner notes, the specific layout and configuration of columns and headings to not act to patentably distinguish the instant invention....merely shifting columns and subcategory headings is a matter of design choice.....”

The Examiner appears to be saying that these claimed features might be unpatentable under an “obvious to try” to test. However, Examiner is well aware that “obvious to try” is not the standard for determining inventiveness. See also *In re Kaplan*, 789 F. 2d at 1580, 229 U.S.P.Q. at 683, where the court held:“In effect, what the Board did was to use a disclosure of appellants’ own joint invention which had been incorporated in the Kaplan sole disclosure to show that their invention was but an

obvious variation of Kaplan's claimed invention. That amounts to using an applicant's invention disclosure, which is not ... prior art... That is impermissible."

Thus, the examiner CANNOT MAINTAIN and obvious to try rejection over the claimed features. For at least these reasons alone, this rejection must be removed, and any future rejection be made nonfinal and require citing a reference and not the examiner's personal feelings to reject the claims.

Claims 14 and 16 were rejected under sec. 103 as being unpatentable over Bidz in view of Chinn and Yahoo. The Yahoo reference does not overcome the deficiencies to the Chinn reference. Thus, removal of this rejection is respectfully requested.

Claim 20 was rejected under sec. 103 as being unpatentable over Bidz in view of Sheth. Claim 20 was amended to claim use of a "handheld display device" and the "single vertical column...." These features are clearly not covered by the Sheth reference. Thus, removal of this rejection is respectfully requested.

Claims 28-29 were rejected under sec. 103 as being unpatentable over Bidz in view of Jammes. Claim 28 was amended to claim use of a "handheld display device" and the "single vertical column...." These features are clearly not covered by the Jammes reference. Thus, removal of this rejection is respectfully requested.

The mere fact that someone in the art can rearrange parts of a reference device to meet the terms of a claim is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for someone of ordinary skill in the art, without the benefit of the inventor's specification to make the necessary changes in the reference device. *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

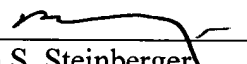
There is no teaching, nor suggestion for modifying the references of record to include all the novel features of the amended claims. Under well recognized rules of the MPEP (for example, section 706.02(j)), the teaching or suggestion to make the claimed

combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438(Fed. Cir. 1991).

Applicant contends the references cannot be modified to incorporate the features of subject claims without utilizing Applicant's disclosure. The courts have consistently held that obviousness cannot be established by combining the teachings of the prior art to Applicant to produce the claimed invention, absent some teaching, suggestion, incentive or motivation supporting the combination.

It is respectfully urged that claims 1, 2, 6-9, 12-14, 16, 20, 23, 24, and 26-29 be allowed. Such action is respectfully requested. If the Examiner believes that an interview would be helpful, the Examiner is requested to contact the attorney below.

Respectfully Submitted;



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